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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/920,806      | 08/03/2001  | Laurent Lecourt      | S 5435              | 7152             |

466 7590 09/03/2004

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EXAMINER

MENDOZA, MICHAEL G

ART UNIT PAPER NUMBER

3731

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/920,806

Applicant(s)

LECOURT ET AL

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-14, and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see page 2, lines 10-18, filed 1 June 2004, with respect to the rejection(s) of claim(s) 1-8, 10-14, and 16-19 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Keller et al. WO 00/06121 (translated in U.S. Patent 6,585,958 to Keller et al.).

### ***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-8, 10-14, and 16-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Keller et al. WO 00/06121 (translated in U.S. Patent 6,585,958 to Keller et al.).

3. Keller et al. teaches a method for manufacturing an inhalable medicament or part of an inhalable medicament for the treatment or prevention of pain in humans or animals, comprising: combining gaseous nitrogen protoxide (N<sub>2</sub>O) to at least on active product selected from the group consisting of paracetamol, acetylsalicylic acid, arylcarboxylic acid, corticosteroids, mineralosteroids, non-steroidal anti-inflammatory drugs and their derivatives, codeine and its derivatives, morphine, and morphine mimetics; wherein the active product is chosen from among analgesics; wherein the active product is chosen from among compounds with an anti-inflammatory action; wherein the active product is chosen from among antipyretics (pgs. 15-17; translated in '958, col. lines 3-67 thru col. 9, lines 1-23); wherein the inhalable medicament further

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comprises a second gas selected from the groups consisting of helium, oxygen, nitrogen, xenon, hydrogen, carbon monoxide (CO), carbon dioxide (CO<sub>2</sub>), argon, krypton, nitrogen monoxide (NO), carbonated hydrocarbons, fluorocarbons, and mixtures of several of the gases (pg. 14, lines 21-30; translated in '958, col. 7, lines 48-57); wherein the inhalable medicament is in the form of an aerosol comprising the gas and the active product in the form of a powder, liquid or a powder/liquid mixture (pg. 18, lines 13-31; translated in '958 col. 9, lines 43-61); it would be inherent wherein the inhalable medicament contains a therapeutically effective quantity of active product; it would be inherent wherein the combination of the at least one gas with the at least one active product leads to a synergistic effect; and wherein the inhalable medicament comprises O<sub>2</sub> and N<sub>2</sub>O and at least one active product with an analgesic action (pgs. 15-17; translated in '958, col. lines 3-67 thru col. 9, lines 1-23).

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***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (703) 305-3285. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dawson can be reached on (703) 308-4304. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



MM  
August 26, 2004



GLENN K. DAWSON  
PRIMARY EXAMINER